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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,181	10/09/2003	Tomoaki Matsugi	1188-0116P	7868
2292	7590	11/30/2004		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
			EXAMINER ASINOVSKY, OLGA	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,181

Applicant(s)

MATSUGI ET AL.

Examiner

Olga Asinovsky

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/09 & 06/17/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Janssen et al U.S. patent 6,127,481.

Janssen discloses a branched polyolefin comprising a plurality of polyolefin arms attached to the reactive polymer backbone and a process for producing said branched polyolefin. A polyolefin pre-arm is polyolefin polymer containing a carbon to carbon double bond in a terminating monomer unit such that it can react with a functional polymer or a difunctional polymerizable monomer, column 3, lines 51-66 and column 4, lines 65-67. The polyolefin pre-arms are readable in applicants' claimed block represented by the formula (1). The polyolefin prearms can be produced by anionic polymerization technique in the presence of Ziegler-Natta catalyst, column 6, line 22. The polyolefin pre-arms may contain a small amount of a functional ethylenically unsaturated monomer such as a maleic anhydride or (meth)acrylate ester, column 7, lines 10-25 and column 15, lines 48-67. Reactive polymer backbones are polymers having functional group, column 5, lines 16-26 and 39-41. Ethylene copolymer with ethylenically unsaturated carboxylic acids, esters or anhydrides is readable in

applicants' claims for being block represented by the formula (2). Also, the reactive backbone polymer can be a polyolefin having a silane hydrolizable unit, column 13, lines 3-10. A process for producing a branched polyolefin in Janssen's invention is readable in applicants' claim 3, column 15, lines 14-67 and column 16, lines 1-67.

Branched polyolefin polymers can be used as fuels and/or lubricating additives and modifiers, column 34, lines 32-34 and column 35, lines 21-44.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,753,378.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-10 of Patent 6,753,378 discloses a branched polyolefin and a process for making said branched polyolefin, wherein the branched polyolefin comprising an olefin chain (A) and olefin chain (B), wherein the chemical formulation of chains (A) and (B) are readable in applicants' claims. The functionalized polyolefin of

(A) polymer having functional (carboxyl) group (C) is readable in applicants' claimed block (2). The terminal modified polyolefin (D) that is referring to a polymer (B) is readable in applicants' claimed block represented by the formula (1). The difference between the present claims and claims 1-10 of Patent, 6,753,378 is that claims 1-10 of said Patent'378 does not disclose a linking group F in the applicants' formula (2). However, it would have been obvious to one of ordinary skill in the art to consider that a linking group L can be present since a grafted monomer having carboxylic group can be any derivative of carboxylic acid for producing a functionalized polyolefin.

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. The prior art is relevant to show the state of the art knowledge.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 571-272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

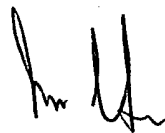
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



O.A.
November 24, 2004

Olga Asinovsky
Examiner
Art Unit 1711



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700